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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,448	12/03/2003	Jefferson Craig Lind	988.1045000	6733

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EXAMINER	
MCCULLOCH JR, WILLIAM H	
ART UNIT	PAPER NUMBER
3714	
MAIL DATE	DELIVERY MODE
05/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/726,448	LIND ET AL.	
	Examiner	Art Unit	
	William H. McCulloch	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 20-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 20-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to amendments received 12/23/2008. Claims 1-18 and 20-24 are pending in the application, with claim 3 currently amended.

Claim Objections

2. Claims 15 and 18 are objected to because of the following informalities: claim 15 has a spacing problem before the period at the end of the claim, and claim 18 recites "and_being" on the second line of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Bilski* (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-7, 9-15, 17-18, 20-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2003/0003980 to Moody (hereinafter Moody) in view of U.S. 2004/0058727 to Marks et al. (hereinafter Marks).

Regarding claims 1, 9, 18 and 20, Moody teaches a method, system, and program product including the following:

(a) obtaining a game play result (e.g., outcome of the base game) for a player in response to a game play request, the game play request made in direct response to the player activating a base game play input in a game (e.g., player initiates primary game; see at least pars. 14-19), the game play result being for a base game play round and specifying a prize value (which is interpreted as a prize value for the bonus game) and being obtained independently of play in a bonus round for the game (e.g., determination of a base game outcome is established before the player plays a bonus round; see at least pars. 14-19);

(b) associating the game play result with the bonus round (a determined outcome of the primary game indicates that a bonus round will be performed by the gaming machine; see at least pars. 17-20);

(c) after the game play request in the game, enabling the player to play the bonus round by presenting the player with a number of selection options from which to choose and enabling the player to make a selection from among the selection

options (e.g., the player makes selections by answering at least one multiple-choice question in the bonus game; see at least pars. 20-23);

(d) concealing the prize value from the player during the bonus round until the player makes the selection (the player is unaware of the bonus prize amount until making at least one selection; see Id.);

(e) in response to the selection, displaying a prize value (Note: While Moody teaches displaying a prize value as a result for the bonus round, it is not the same prize value as recited in section (a) above) to the player as a result for play of the bonus round (as before, the player is unaware of the bonus prize amount until making at least one selection; see Id).

Moody teaches the invention substantially as described above. With respect to section (e) above, Moody teaches displaying a prize value in the bonus round, but lacks in teaching that the prize value displayed as a result of the bonus round is the same as the prize value specified by the "game play result," as described in sections (a) and (e) above. Instead, Moody teaches that the base game outcome is randomly determined by, e.g., a slot machine known in the art (par. 16) and further teaches that the outcome of the secondary or bonus game is randomly determined by computer controls if and when the player wins the chance to play the secondary or bonus game (par. 19). In other words, Moody teaches that both the base game and the bonus game are randomly determined, albeit by two independent random events, resulting in a game that is completely determined by chance (i.e., no skill on the part of the player influences any game outcome).

In a related disclosure, Marks teaches a gaming system comprising one or more gaming devices 10 and, in one embodiment, the gaming devices are connected over a remote communication link 54 to a central server or central controller 52 (see par. 53). Marks further teaches that, "Upon a player initiating game play at one of the gaming devices, the initiated gaming device communicates a game outcome request to the central server or controller" (par. 54). Marks teaches that the central server may randomly generate a game outcome for the primary, secondary, or primary and secondary games (par. 55), or the central server may select a predetermined game outcome for the primary, secondary, or primary and secondary games from a pool of predetermined game outcomes (par. 56). It is noted that Marks specifically teaches that the game outcome request submitted by the gaming device to the central server at the initiation of the game, and that the outcome generated is for both the primary and secondary games.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Moody such that the game play result is for a base game play round and specifies a prize value for a bonus game, as is favorably taught by Marks in order to "assist the gaming establishment in reducing and preventing cheating or electronic or other errors [and] reducing or eliminating win-loss volatility" (Marks, par. 57).

Regarding claims 2 and 17, Moody teaches a method further including obtaining an additional game play result for the player in response to an additional game play result in the game, the additional game play result comprising a non-bonus round game

play result and being associated with a respective prize value, and also including responding to the non-bonus round game play result by displaying to the player the respective prize value associated with the non-bonus round game play result, the non-bonus round game play result not being associated with the bonus round (Moody teaches such in a subsequent, non-bonus outcome of the primary game; see at least pars. 16-17).

Regarding claim 3, Moody teaches wherein the game comprises a bingo type game (see pars. 16 and 18). Furthermore, Marks teaches that the primary game may include video bingo (par. 44) and that the bonus or secondary game may be similar to or different from the primary game (par. 50). With respect to the claim recitations, a real or electronic card that includes a number of symbols randomly arranged in a grid of spots or location and having drawn symbols matched to the symbols on the card is an inherent feature of a bingo game, such as the games taught by references to Moody and Marks. Furthermore, a bingo card pattern included in a game play result is necessary in both references because the game of bingo requires a particular card pattern in order to determine of a player is a winner or not. Thus, the features of claim 3 are taught by the combined teachings of Moody and Marks.

Regarding claims 4 and 11, Moody further teaches that associating the game play result with the bonus round is performed in response to a random event (e.g. the bonus round is initiated in response to a randomly-selected combination of symbols on a play line of a video slot machine; see at least par. 17). Furthermore, Marks teaches

that the central server may randomly generate a game outcome for the primary, secondary, or primary and secondary games (9:14-22).

Regarding claims 5, 12, and 21, Moody further teaches that associating the game play result with the bonus round is performed in response to a predetermined event (e.g., when the base game yields a predetermined outcome that allows the player a chance to play a bonus round; see at least pars. 16-17). Furthermore, Marks teaches that the central server may select a predetermined game outcome for the primary, secondary, or primary and secondary games from a pool of predetermined game outcomes (9:26-40)

Regarding claim 6, Moody teaches that the step of associating the game play result with the bonus round is performed according to a predetermined relationship between the game play result and the bonus round (similar to the explanation of claim 4, Moody teaches that the association of the game play result with the bonus round is performed according to a relationship between the symbols on a payline and the predetermined set of primary game outcomes that yield a bonus round.)

Regarding claims 7, 15, and 22, Moody teaches the limitations of the claim by displaying the graphical depictions associated with the selection bonus game, as described above.

Regarding claims 10, 13, and 14, Moody teaches a bonus association controller (computer controls of the electronic gaming machine; see at least paragraph 14). Furthermore, Marks teaches a bonus association controller in the central server or controller, and teaches that "some or all functions of each gaming device [are] provided

at a central location such as a central server or central controller 52" (par. 53). The latter teaching of Marks suggests that any feature of the central controller or server may be performed by the gaming machine or vice versa.

Regarding claim 24, Moody teaches performing a table look up to identify the prize value specified by the game play result at least because the game device (i.e., computer controls) randomly selects an award from a pool of possible awards (see at least par. 19). The pool of possible awards corresponds to the claimed "table" because they are both logical collections of numbers. Selection of one award from the collection of awards is interpreted as performing a "look up".

7. Claims 8, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody and Marks in view of Admitted Prior Art.

Claims 8, 16, and 23 are directed toward a bonus game wherein a player is presented with a number of selection options from which to choose and is a graphical depiction of a number of participants in a contest. The combination of Moody and Marks teaches the invention substantially as described above but lacks in explicitly teaching that players may choose participants of a contest. As was detailed in the previous rejections, it was notoriously well known in the art to offer bonus games wherein a player may select one or more racers, for instance horses in a race, on which to place bets and possibly win bonus prizes. Applicant has not seasonably challenged the Examiner's assertion that it was known in the art at the time of invention to offer such games wherein the player selects objects representative of participants in a contest, and as such that assertion is admitted prior art. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of invention to modify the combination of Moody and Marks in order to allow players to play a game having a graphical depiction of a number of objects representing respective participants in a contest in order to provide electronic representations of real life events.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
4/27/2009

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714